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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,811	01/13/2004	Michael Tjader	1523.056US1	1505
21186	7590	09/06/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			COY, NICOLE A	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/756,811	Applicant(s) TJADER, MICHAEL	
	Examiner Nicole Coy	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7-14,19,21 and 22 is/are rejected.
- 7) ☒ Claim(s) 2,3,6,20 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how a number of pipe engaging elements can be retained by an interference fit. It appears that only the pipe engaging element closest to the retention feature would be an interference fit. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4-5, 8-11, 13, and 19 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Carter et al. (US Application 2002/0067954).

With respect to claim 1, Carter et al. discloses a pipe breaking device, comprising: a base unit (see figure 2 number 140); a retention feature located on the base unit (see figure 2, numerals 188, 196, and 160); a cable attachment portion located at a first end of the base unit (see figure 2 numeral 48); and a number of pipe engaging elements wherein the pipe engaging elements are retained on the base unit by the retention feature, and wherein the number of pipe engaging elements are removable from the base unit and interchangeable (see figure 2 numerals 56 and 52 and column 3 paragraph [0054]) in multiple positions along a length of the base unit (wherein 56 and 52 are multiple positions along the length of the base unit).

With respect to claim 4, Carter et al. discloses that the retention feature includes a threaded fastener that connects at least one of the number of pipe engaging elements to the base unit (see figure 2 numeral 160 and column 3 paragraph [0052]).

With respect to claim 5, Carter et al. discloses a pipe breaking device further including a pipe gripping device located at a second end of the base unit, opposite the cable attachment location (see figure 2 numeral 156 and column 3 paragraph [0052]).

With respect to claim 8, Carter et al. discloses at least one of the number of pipe engaging elements includes a cutting blade (see figure 2 numeral 56).

With respect to claim 9, Carter et al. discloses that the cable attachment portion includes a threaded portion adapted to mate with a corresponding threaded portion on the first end of the base unit (see figure 24 numeral 1194).

With respect to claim 10, Carter et al. discloses the cable attachment portion includes multiple segments adapted for assembly around a cable (see figure 24).

With respect to claim 11, Carter et al. discloses a pipe breaking device, comprising: a base unit (see figure 2 number 140); a protruding retention feature located on the base unit (see figure 2, numerals 188, 196, and 160); a threaded cable attachment portion located adapted to mate with a corresponding threaded portion on a first end of the base unit (see figure 24 numeral 1194); a number of pipe engaging elements wherein the pipe engaging elements are retained on the base unit by the retention feature, and wherein the number of pipe engaging elements are removable from the base unit and interchangeable (see figure 2 numerals 56 and 52 and column 3 paragraph [0054]) in multiple positions along a length of the base unit (wherein 56 and 52 are multiple positions along a length of the base unit); and a pipe gripping device located at a second end of the base unit, opposite the cable attachment location (see figure 2).

With respect to claim 13, Carter et al. discloses at least one of the number of pipe engaging elements includes a cutting blade (see figure 2 numeral 56).

With respect to claim 19, a pipe breaking device, comprising: a base unit (see figure 2 number 140); an interference fit retention feature (see figure 2, numerals 188, 196, and 160) located on the base unit; and a number of pipe engaging elements (52, 56) wherein the pipe engaging elements (52,56) are removable from the base unit and interchangeable (see figure 2 numerals 56 and 52 and column 3 paragraph [0054]) in multiple positions along a length of the base unit (wherein 56 and 52 are multiple positions along the length of the base unit).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter et al. in view of Lincoln.

With respect to claims 7 and 12, Carter et al. is silent as to whether the expander cone is a pipe engaging element which is removable and interchangeable. Lincoln teaches a removable and interchangeable expander cone in order to allow for the removal of the bursting ram in limited space (see figure 4A and column 3 lines 8-15). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the pipe breaking device of Carter et al. by including a removable expander cone as taught by Lincoln in order to allow for the removal of the device in limited space.

With respect to claim 14, Lincoln teaches at least one of the number of pipe engaging elements includes a cutting blade (see figure 4A and column 3 lines 8-15). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the pipe breaking device of Carter et al. by including a removable expander cone and cutting blade as taught by Lincoln in order to allow for the removal of the device in limited space.

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7. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter et al. in view of Lumpp et al. (USP 4,247,163).

Carter et al. discloses a pipe breaking device, comprising: a base unit (140); at least one pipe engaging element (52) located along a length of the base unit; and a cable holding device (48) to selectively attach to a first end of the base unit. Carter et al. does not disclose that the cable holding device includes a plurality of segments that are laterally removeable from a portion of a cable and a threaded portion on the surface of the plurality of the segments to thread into the first end of the base unit. Lumpp et al. teaches a cable holding device having a plurality of segments (24) which are threaded (see figure 2) to engage a base unit. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Carter et al. by including the cable holding device as taught by Lumpp et al. in order to securely engage a cable and securely attach that cable to a base unit.

Allowable Subject Matter

7. Claims 2, 3, 6, 20, and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 2/13/06 have been fully considered but they are not persuasive. With respect to claims 1 and 11, the applicant argues that Carter does not

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disclose pipe engaging elements that are removable from the base unit and interchangeable in multiple positions along a length of the base unit. However, Carter does disclose pieces 52 and 56 that are removeable and interchangeable. Furthermore, as pieces 52 and 56 are in two different positions along the length of the base unit, the pipe engaging elements are removeable and interchangeable in multiple positions along a length of the base unit. It is noted that the Applicant doesn't define the relationship of the pieces to each other.

The rejection of 1-3 and 7 over Lincoln has been withdrawn in view of the amendments filed. Lincoln does not disclose a number of pipe engaging elements that are removable from the base unit and interchangeable in multiple positions along a length of the base unit.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole Coy whose telephone number is 571-272-5405. The examiner can normally be reached on M-F 7:30-5:00, 1st F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

nac


William Neuder
Primary Examiner